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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/489,817	01/24/2000	Muhammed Habibur Rahman	674550-2001	6308
20999	7590	11/06/2003		
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			EXAMINER MCELWAIN, ELIZABETH F	
			ART UNIT	PAPER NUMBER

1638

DATE MAILED: 11/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

### Office Action Summary

**Application No.**

09/489,817

**Applicant(s)**

RAHMAN ET AL.

**Examiner**

Elizabeth F. McElwain

**Art Unit**

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 110-115, 119, 123 and 127 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 110-115, 119, 123 and 127 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/26/02 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Prosecution Application***

1. The request filed on April 16, 2003 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/489,817 is acceptable and a CPA has been established. An action on the CPA follows. Applicant has requested an examination on the currently pending claims which are drawn to claims that were non-elected in the original application.
2. Claims 110-115, 119, 123 and 127 are pending and are examined in the present office action.
3. New corrected drawings are required in this application because in Figure 1, at the bottom right corner, "B." is recited without a species name. In addition, at the bottom left corner "B. oleracea campestris" thereby including two species names. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 110-15, 119, 123 and 127 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 110 and all claims dependent thereon are indefinite in that it depends upon cancelled claim 36. The claims have been examined as if all of the limitations of claim 36 have been incorporated. However, correction is required.

7. Claim 110 and all claims dependent thereon are also indefinite in the recitation of "one or more transparent seed coat gene", since it is unclear if this trait requires more than one gene, and if so, what would constitute these multiple genes? Furthermore, gene should be recited as plural.

8. Claim 110 and all claims dependent thereon are also indefinite in that claim 110 is missing required steps for plant transformation and tissue culture steps prior to chromosome doubling and embryo rescue, and then steps resulting in a transformed Brassica CC genome. The claim is also confusing in that it is unclear how the chromosome doubling and embryo rescue steps relate to one another and to the method as a whole.

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 110-115, 119, 123 and 127 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, for the reasons of record set

forth in the office action of October 10, 2001, given that since the transparent seed coat genes and genomes are not adequately described, neither are methods requiring the same.

10. Claims 11-115, 119, 123 and 127 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claims are drawn to a method for preparing a transformed Brassica CC genome comprising transferring one or more transparent seed coat genes of a Brassica AA genome, chromosome doubling and embryo rescue, including that the CC genome is not derived from *Brassica carinata*. However, the specification does not disclose an exogenous (isolated) transparent seed coat gene from any Brassica species, much less more than one transparent seed coat gene. Therefore, the specification also does not teach transforming another Brassica species with an exogenous transparent seed coat gene. The specification does not teach a transparent seed coat gene, nor does it provide guidance for identifying and isolating a transparent seed coat gene, much less for transforming another plant with said gene. In addition, there is no guidance in the specification with regard to transforming a Brassica genome along with the steps of chromosome doubling and embryo rescue. Furthermore, the specification does not teach transparent seed coat genes from a CC genome that is not derived from *B. carinata*, since all of the examples of Brassica CC genomes provided in the specification are derived from crosses with *Brassica carinata* (see pages 18-20 and 24, Figures 2 and 3).

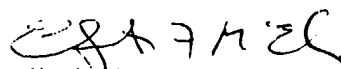
Given the unpredictability of identifying and isolating one or more transparent seed coat genes from a Brassica genome, given the lack of working examples of one or more of said genes that have been isolated, given the absence of guidance regarding isolation of said gene or genes, transformation of another Brassica species and the use of chromosome doubling and embryo rescue, given the breadth of the claims which encompass multiple transparent seed coat genes transformed into numerous Brassica species, and given the state of the prior art which does not teach isolated transparent seed coat genes, it would require undue experimentation by one skilled in the art to make and/or use the invention.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth F. McElwain whose telephone number is 703-308-1794. The examiner can normally be reached on increased flex time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on 703-306-3218. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Elizabeth F. McElwain  
Primary Examiner  
Art Unit 1638